UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
NEURAUTER, GEORGE C

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO 90C (Rev 10/03)

	Application No.	Applicant(s)
	09/497,383	BAHR ET AL.
Office Action Summary	Examiner	Art Unit	
	George C. Neurauter, Jr.	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>07 May 2004</u>.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-16,18-27,29-33,35-53 and 55-76* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-16,18-27,29-33,35-53 and 55-76* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

    1. ☐ Certified copies of the priority documents have been received.

    2. ☐ Certified copies of the priority documents have been received in Application No. _____.

    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7 May 2004</u>.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claims 1-16, 18-27, 29-33, 35-53, and 55-76 are currently
pending and have been examined.

Response to Amendment

The affidavits under 37 CFR 1.132 filed 7 May 2004 is
sufficient to overcome the rejection of claims 1-16, 18-27, 29-
33, 35-53, and 55-59 based upon "LEADTOOLS".

Response to Arguments

Applicant's arguments with respect to claims 1-16, 18-27,
29-33, 35-53, and 55-76 have been considered but are moot in
view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35
U.S.C. 112:

> The specification shall contain a written description of the invention, and
> of the manner and process of making and using it, in such full, clear,
> concise, and exact terms as to enable any person skilled in the art to
> which it pertains, or with which it is most nearly connected, to make and
> use the same and shall set forth the best mode contemplated by the inventor
> of carrying out his invention.

Claim 76 is rejected under 35 U.S.C. 112, first paragraph,
as failing to comply with the written description requirement.
The claim(s) contains subject matter which was not described in
the specification in such a way as to reasonably convey to one
skilled in the relevant art that the inventor(s), at the time

the application was filed, had possession of the claimed
invention.

Claim 76 recites the limitation "wherein the server is
operated in an application service provider (ASP)
configuration." There is no written description of this
limitation in the specification. It would require undue
experimentation for one of ordinary skill in the networking art
to determine the detail teachings that are needed in order to
build or practice the invention.

The following is a quotation of the second paragraph of 35
U.S.C. 112:

> The specification shall conclude with one or more claims particularly
> pointing out and distinctly claiming the subject matter which the applicant
> regards as his invention.

Claims 1-16, 18-27, 29-33, 35-53, and 55-76 are rejected
under 35 U.S.C. 112, second paragraph, as being indefinite for
failing to particularly point out and distinctly claim the
subject matter which applicant regards as the invention.

Claims 1, 27, 41, 50, 55, and 57 recite generating a
display using a document, specifically an HTML document, which
is displayed within a web browser. It is not clear as to where
this document is transmitted from, whether it is sent from the
client, a server coupled to the network, or the scanner that
scans a document and provides document data that is included

within the document. It is also not clear how this document is produced, since the document is normally produced by a web server as is known to those of ordinary skill in the art.

Claims 1, 27, 41, 50, 55, and 57 recite using a send data signal or second command at the client to send the document data and index data to a server. However, page 13, lines 1-3, of the specification recites:

"The browser 32 includes an address field for entering a network address such as a universal resource locator (URL) for uploading the document data 40 and optional index data 41 from the processor 12 to the server(s) 28, 29."

In view of this disclosure, the claims do not appear to particularly point out what the applicant regards as the invention and directly contradict with the claim language.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United

States and was published under Article 21(2) of such treaty in the English
language.

Claims 1, 3-16, 20-27, 29-33, 37-53, 55-60, 63-69, and 72-
76 are rejected under 35 U.S.C. 102(e) as being anticipated by
US Patent 6 424 996 B1 to Killcommons et al.

Regarding claim 1, Killcommons discloses a method
comprising the step of:

a) generating a display based on a hypertext mark-up
language (HTML) document using a web browser of a user interface
of a client device (column 11, lines 4-29), the display
including a document display portion (column 15, lines 3-30), an
index field portion (column 6, lines 53-67), and a control
portion (column 13, lines 7-29; column 15, lines 18-30) all
visibly defined in the display by the HTML document, the
document display portion including a display of document data
representing the scanned document (column 7, lines 23-43,
specifically lines 33-34; column 13, lines 30-37; column 15,
lines 3-30, specifically lines 3-6, 10-11, and 17-30), the index
field portion permitting index data to be input to the user
interface in association with the document data (column 4, lines
37-46; column 5, lines 50-55; column 6, lines 53-67), and the
control portion including at least one control element for
generating a start scan signal to initiate scanning of a

document with a scanner to generate the document data (column 7,

lines 23-43, specifically lines 33-34; column 11, lines 19-39;

column 15, lines 3-30, specifically lines 3-6, 10-11, and 17-30)

and a send data signal to transmit the document data with the

index data displayed by the web browser from the client device

to a server over a network (column 5, lines 50-55; column 7,

lines 1-10; column 12, lines 13-21).

Regarding claim 3, Killcommons discloses a method as

claimed in claim 1, wherein the control portion includes at

least one control element that can be activated to adjust the

scale of the display of the document data. (column 13, lines 59-

63)

Regarding claim 4, Killcommons discloses a method as

claimed in claim 3, wherein the control element can be activated

to increase the scale of the display of the document data ("zoom

in"). (column 13, lines 63-67)

Regarding claim 5, Killcommons discloses a method as

claimed in claim 3, wherein the control element can be activated

to decrease the scale of the display of the document data ("zoom

out"). (column 13, lines 63-67)

Regarding claim 6, Killcommons discloses a method as

claimed in claim 3, wherein the control element can be activated

to scale the document data to fit within the document display
portion of the user interface. (column 13, lines 63-67)

Regarding claim 7, Killcommons discloses a method as
claimed in claim 3, wherein the control element can be activated
to scale the document data for display in the document display
portion to the same scale as the scanned document. (column 13,
lines 63-67)

Regarding claim 8, Killcommons discloses a method as
claimed in claim 3, wherein the control portion includes a
control element to select document data from among a plurality
of scanned documents for display on the document display portion
of the display. (column 13, lines 30-51)

Regarding claim 9, Killcommons discloses a method
comprising the steps of:

a) generating a start scan signal using a control element
destined by a hypertext mark-up language (HTML) document
displayed by a web browser of a user interface of a client
device; (column 11, lines 4-29; column 15, lines 3-30,
specifically lines 3-6, 10-11, and 17-30)

b) at the client device, converting the start scan signal
into a form compatible with a scanner; c) transmitting the
converted start scan signal from the client device to the
scanner; d) receiving the converted start scan signal at the

scanner; and e) scanning a document with the scanner to generate

document data, in response to the converted start scan signal

received in said step (d). (column 11, lines 19-39; column 12,

lines 13-20; column 15, lines 3-30, specifically lines 3-6, 10-

11, and 17-30)

Regarding claim 10, Killcommons discloses a method as

claimed in claim 9, wherein said step (a) is performed by

depressing and releasing the control element of the user

interface defined by the HTML document displayed by the web

browser of the client device using a mouse. (column 13, lines

17-20)

Regarding claim 11, Killcommons discloses a method as

claimed in claim 9, further comprising the steps of:

f) transmitting the document data from the scanner to the

client device; g) receiving the document data at the client

device; h) at the client device, converting the document data

into a form that can be displayed within the web browser of the

client device; and i) generating a display including the scanned

document on the web browser of the client device, based on the

document data converted in step (h). (column 11, lines 19-39;

column 12, lines 13-20; column 15, lines 3-30, specifically

lines 3-6, 10-11, and 17-30)

Regarding claim 12, Killcommons discloses a method as
claimed in claim 11, further comprising the step of:

j) adjusting the display of the document data via the user
interface using a control element defined in the HTML document
within the web browser. (column 13, lines 7-16)

Regarding claim 13, Killcommons discloses a method as
claimed in claim 12, wherein the adjusting of said step (j)
includes increasing the scale of the display of the scanned
document ("zooming in") on the user interface in the web
browser. (column 13, lines 63-67)

Regarding claim 14, Killcommons discloses a method as
claimed in claim 12, wherein the adjusting of said step (j)
includes decreasing the scale of the display of the scanned
document ("zooming out") on the user interface in the web
browser. (column 13, lines 63-67)

Regarding claim 15, Killcommons discloses a method as
claimed in claim 12, wherein the adjusting of said step (j)
includes scaling the display of the scanned document to fit
within the document display portion of the display of the user
interface in the web browser of the client device. (column 13,
lines 63-67)

Regarding claim 16, Killcommons discloses a method as
claimed in claim 12, wherein the adjusting of said step (j)

includes generating the display of the scanned document on the user interface in the web browser of the client device with the same scale as the scanned document. (column 13, lines 63-67)

Regarding claim 20, Killcommons discloses a method as claimed in claim 11, further comprising the steps of:

j) inputting predetermined index data into an index field defined by the HTML document displayed by the web browser of the user interface of the client device; (column 4, lines 37-46; column 5, lines 50-55; column 6, lines 53-67)

k) generating a send data signal using the control element defined by the HTML document displayed by the web browser of the user interface of the client device; l) transmitting the document data and index data from the client device to the a server over an internetwork in response to the send data signal generated in said step (k); m) receiving the document data and index data at the server; (column 5, lines 50-55; column 7, lines 1-10; column 12, lines 13-21) and

n) storing the document data in association with the index data in a database of a data storage unit. (column 16, lines 14-27)

Regarding claim 21, Killcommons discloses a method as claimed in claim 20, wherein the index data includes

predetermined identification data to identify the document.

(column 6, lines 53-67)

Regarding claim 22, Killcommons discloses a method as

claimed in claim 20, wherein the document data and the index

data are transmitted between the server and client device in

hypertext transfer protocol (HTTP). (column 10, line 58-column

11, line 3, specifically column 11, line 3; column 11, lines 18-

29, specifically lines 19-21)

Regarding claim 24, Killcommons discloses a method as

claimed in claim 20, wherein the start scan signal is input by a

user via a first control element of the user interface defined

in the HTML document displayed by the web browser for a first

scan mode in the performance of said step (a) (column 7, lines

23-43, specifically lines 33-34; column 11, lines 19-39; column

15, lines 3-30, specifically lines 3-6, 10-11, and 17-30) and

the send data signal is input by a user via a second control

element of the user interface in the performance of said step

(1). (column 5, lines 50-55; column 7, lines 1-10; column 12,

lines 13-21)

Claim 25 is rejected since claim 25 contains the same

limitations as recited in claim 9.

Regarding claim 26, Killcommons discloses a method as

claimed in claim 9, further comprising the step of:

f) transmitting the document data from the scanner to the
client device; g) receiving the document data at the client
device; (column 11, lines 19-39; column 12, lines 13-20; column
15, lines 3-30, specifically lines 3-6, 10-11, and 17-30) and

h) transmitting the document data from the client device to
a server. (column 5, lines 50-55; column 7, lines 1-10; column
12, lines 13-21)

Claim 27 is rejected since claim 27 contains the same
limitations as recited in claims 9, 11, and 20 in combination.

Claims 29-33 and 37-40 are rejected since these claims
contain substantially the same limitations as recited in claims
3-7 and 21-24 respectively.

Claims 41-48 are rejected since these claims contain
substantially the same limitations as recited in claims 1-8
respectively.

Claim 49 is rejected since claim 49 contains substantially
the same limitations as recited in claim 20.

Claim 50 is rejected since claim 50 contains substantially
the same limitations as recited in claims 1 and 20 in
combination.

Regarding claim 51, Killcommons discloses a system as
claimed in claim 50, wherein the network includes an
internetwork. (column 10, line 58-column 11, line 3,

specifically column 11, line 3; column 11, lines 18-29,

specifically lines 19-21)

Regarding claim 52, Killcommons discloses a system as

claimed in claim 50, wherein the client device includes a

personal computer. (column 11, lines 4-17)

Regarding claim 53, Killcommons discloses a system as

claimed in claim 50, wherein the user interface includes a web

browser that executes the HTML document to generate the display

in which the document data is displayed. (column 11, lines 18-

29)

Claim 55 is rejected since claim 55 contains substantially

the same limitations as recited in claims 1 and 20 in

combination.

Claim 56 is rejected since claim 56 contains substantially

the same limitation as recited in claim 51.

Claim 57 is rejected since claim 57 contains substantially

the same limitations as recited in claims 1 and 20 in

combination.

Claim 58 is rejected since claim 58 contains substantially

the same limitations as recited in claim 11.

Claim 59 is rejected since claim 59 contains substantially

the same limitations as recited in claim 20.

Regarding claim 60, Killcommons discloses a method as claimed in claim 1 further comprising: b) inputting index data identifying the scanned document into the index field portion. (column 4, lines 37-46; column 5, lines 50-55; column 6, lines 53-67)

Regarding claim 63, Killcommons discloses a method as claimed in claim 60 wherein the index data comprises a file path indicating the subdirectory on the server at which the scanned document is to be stored. (column 9, lines 5-10)

Regarding claim 64, Killcommons discloses a method as claimed in claim 60 wherein the index data comprises text explaining the nature of the scanned document. (column 6, lines 53-67)

Regarding claim 65, Killcommons discloses a method as claimed in claim 60 wherein the index data identifies a matter to which the scanned document relates. (column 6, lines 53-67)

Regarding claim 66, Killcommons discloses a method as claimed in claim 60 wherein the index data identifies a transaction to which the scanned document relates. (column 6, lines 53-67)

Regarding claim 67, Killcommons discloses a method as claimed in claim 60 further comprising the step of: b) activating the control element using the user interface to scan

the document with a scanner to generate the document data.

(column 7, lines 23-43, specifically lines 33-34; column 11,

lines 19-39; column 15, lines 3-30, specifically lines 3-6, 10-

11, and 17-30)

Regarding claim 68, Killcommons discloses a method as

claimed in claim 67 further comprising the step of: c)

activating the control element to upload the document data

representing the scanned document to a server over a network.

(column 5, lines 50-55; column 7, lines 1-10; column 12, lines

13-21)

Regarding claim 69, Killcommons discloses a method as

claimed in claim 27 wherein the index data input in said step

(j) identifies the scanned document. (column 4, lines 37-46;

column 5, lines 50-55; column 6, lines 53-67)

Regarding claim 72, Killcommons discloses a method as

claimed in claim 27 wherein the index data comprises a file path

indicating the subdirectory on the server at which the scanned

document is to be stored. (column 9, lines 5-10)

Regarding claim 73, Killcommons discloses a method as

claimed in claim 27 wherein the index data comprises text

explaining the nature of the scanned document. (column 6, lines

53-67)

Regarding claim 74, Killcommons discloses a method as claimed in claim 27 wherein the index data identifies a matter to which the scanned document relates. (column 6, lines 53-67)

Regarding claim 75, Killcommons discloses a method as claimed in claim 27 wherein the index data identifies a transaction to which the scanned document relates. (column 6, lines 53-67)

Regarding claim 76, Killcommons discloses a system as claimed in claim 55 wherein the server is operated in an application service provider (ASP) configuration. (column 4, lines 30-46)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2, 18-19, 23, 35-36, 61-62, and 70-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Killcommons et al.

Regarding claim 2, Killcommons discloses a method as claimed in claim 1.

Killcommons does not disclose wherein the control portion includes a control element used to alternately generate the start scan signal and the send data signal with respective

successive activations of the control element, however,

Killcommons does disclose that the control portion is embodied

within an interface program or "browser enhancement module"

(column 6, lines 25-31).

.Examiner takes Official Notice (see MPEP § 2144.03) that a

control element used to alternately generate the start scan

signal and the send data signal with respective successive

activations of the control element in a user interface was well

known in the art at the time the invention was made as a user

interface widget known as a "toggle button". The Applicant is

entitled to traverse any/all official notice taken in this

action according to MPEP § 2144.03, namely, "if applicant

traverses such an assertion, the examiner should cite a

reference in support of his or her position". However, MPEP §

2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169

USPQ 231 (CCPA 1971) (a challenge to the taking of judicial

notice must contain adequate information or argument to create

on its face a reasonable doubt regarding the circumstances

justifying the judicial notice)." Specifically, *In re Boon*, 169

USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be

given the opportunity to challenge either the correctness of the

fact asserted or the notoriety or repute of the reference cited

in support of the assertion. We did not mean to imply by this

statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

Claim 23 is also rejected since claim 23 recites substantially the same limitations as claim 2.

Regarding claim 18, Killcommons discloses a method as claimed in claim 11.

Killcommons does not disclose the method further comprising the step of (j) generating a multiscan mode signal at a user interface with the control element of the HTML document displayed by the web browser of the client device, said steps (e)-(g) repeatedly performed to generate document data for a plurality of documents, based on the multimode scan signal.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to generate a multiscan mode signal since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner, 120 USPQ 192.*

Claim 35 is also rejected since claim 35 recites substantially the same limitations as recited in claim 18.

Regarding claim 19, Killcommons discloses a method as
claimed in claim 18.

Killcommons does not expressly disclose the method further
comprising the steps of k) generating a selection signal using a
control element defined within the HTML document displayed by
the web browser at the client device indicating at least one of
the first, last, next and previous scanned documents for
display; and l) displaying the document data for one of the
scanned documents, based on the selection signal generated in
said step (k), however, Killcommons does disclose that the web
browser has a control element embodied within an interface
program or "browser enhancement module" (column 6, lines 25-31).

Examiner takes Official Notice (see MPEP § 2144.03) that
displaying document data for one of a plurality of documents
using a control element that displays a first, last, next, and
previous document in a user interface such as an HTML document
displayed in a web browser or interface program within a web
browser was well known in the art at the time the invention was
made as "focus traversal" or "focus control". The Applicant is
entitled to traverse any/all official notice taken in this
action according to MPEP § 2144.03, namely, "if applicant
traverses such an assertion, the examiner should cite a
reference in support of his or her position". However, MPEP §

2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169

USPQ 231 (CCPA 1971) (a challenge to the taking of judicial

notice must contain adequate information or argument to create

on its face a reasonable doubt regarding the circumstances

justifying the judicial notice)." Specifically, *In re Boon*, 169

USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be

given the opportunity to challenge either the correctness of the

fact asserted or the notoriety or repute of the reference cited

in support of the assertion. We did not mean to imply by this

statement that a bald challenge, with nothing more, would be all

that was needed". Further note that 37 CFR § 1.671(c)(3) states

"Judicial notice means official notice". Thus, a traversal by

the Applicant that is merely "a bald challenge, with nothing

more" will be given very little weight.

Claim 36 is also rejected since claim 36 recites

substantially the same limitations as recited in claim 19.

Regarding claim 61, Killcommons discloses a method as

claimed in claim 60.

Killcommons does not disclose wherein the index data

comprises a document name identifying the scanned document.

However, these differences are only found in the

nonfunctional descriptive material and are not functionally

involved in the steps recited. The method of inputting index

data identifying the scanned document would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the nonfunctional descriptive material with the claimed invention because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Claim 70 is also rejected since claim 70 recites substantially the same limitations as recited in claim 61.

Regarding claim 62, Killcommons discloses a method as claimed in claim 60.

Killcommons does not disclose wherein the index data comprises an identification number identifying the scanned document.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method of inputting index

data identifying the scanned document would be performed the

same regardless of the data. Thus, this descriptive material

will not distinguish the claimed invention from the prior art in

terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385,

217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579,

32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of

ordinary skill in the art at the time the invention was made to

include the nonfunctional descriptive material with the claimed

invention because such data does not functionally relate to the

steps in the method claimed and because the subjective

interpretation of the data does not patentably distinguish the

claimed invention.

Claim 71 is also rejected since claim 71 recites

substantially the same limitations as recited in claim 62.

Conclusion

The prior art made of record and not relied upon is

considered pertinent to applicant's disclosure.

US Patent 5 819 092 to Ferguson et al;

US Patent 6 121 970 to Guedalia;

US Patent 6 209 048 to Wolff;

US Patent 6 415 278 to Sweet et al;

US Patent 6 453 127 to Wood et al;

US Patent 6 480 304 to Os et al;

US Patent 6 587 129 to Lavendel et al;

US Patent 6 473 788 to Kim et al;

US Patent 6 567 121 to Kuno;

US Patent 6 633 913 to Chalstrom et al;

IBM Corporation. "Extendable Model for Toggle Button", IBM Technical Disclosure Bulletin, Vol. 37, Issue 2A, pgs. 33-34, 1 February 1994.

NOTE: Effective 29 October 2004, the examiner will be moving to a new office location and may be reached at 571-272-3918.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is 703-305-4565. The examiner can normally be reached on Thursday 1-2pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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